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10/600,600	06/19/2003	John F. Casey	10030747-1	5492

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AGILENT TECHNOLOGIES, INC.  
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EXAMINER	
CHEN, BRET P	
ART UNIT	PAPER NUMBER
1762	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/600,600  
Filing Date: June 19, 2003  
Appellant(s): CASEY ET AL.

**MAILED**  
MAR 16 2005  
**GROUP 1700**

Gregory W. Osterloth  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 3, 2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3)     *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4)     *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. It should be noted that the status stated in the Advisory Action dated October 14, 2004 was incorrect. Claims 1-8, 12, and 14-17 have been allowed.

**(5)     *Summary of Claimed Subject Matter***

The summary of claimed subject matter contained in the brief is correct.

**(6)     *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection is substantially correct. The changes are as follows:

Claims 1-8, 12, and 14-17 have been allowed. The only outstanding rejection is the 112, second paragraph rejection over claims 9-11, 18, and 20.

**(7)     *Claims Appendix***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8)     *Evidence Relied Upon***

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-11, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-10, 18, and 20 contain the trademark/trade name KQ dielectric and KQ CL-90-7858. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the dielectric coating material and, accordingly, the identification/description is indefinite.

**(10) Response to Arguments**

Appellant first argues KQ dielectrics are well known materials as recited in Heraeus Cermalloy's website and published papers and as such the trademark is proper, pursuant to MPEP 608.01(v). (p.8 line 13 to p.9 line 7).

The examiner agrees in part. While KQ dielectrics are well known materials and their trademarks in the disclosure is proper, it is noted that the cited portion of the MPEP is referring to trademarks in the disclosure and not in the claims.

Appellant next argues that the *Ex Parte Simpson* case was a unique case which the Board of Appeals subsequently declined in *Ex Parte Jerry Kitten* (p.9 line 19 – p.10 line 20).

The examiner disagrees. It is first noted that there is no evidence provided supporting the position that *Ex Parte Simpson* was a unique case. Secondly, the appellant relies on *Ex Parte Jerry Kitten*, an unpublished nonbinding opinion. Thirdly, there is no mention anywhere nor is there any factual evidence provided that the decision in *Ex Parte Simpson* was overturned.

Appellant makes other arguments with respect to the Heraeus Cermalloy website (p. 9 lines 8-18 and p.10 line 21 – p.11 line 7) as well as the Examiner's art unit policy (p.11 lines 7-16) to support the position that trademarks in claims are acceptable.

None of these arguments seem to be relevant to justify trademarks in claims. The sole issue of the Appeal is the use of trademarks in claims. To that end, if the trademark or trade name is used in claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name identifies the source of a material and cannot be used to properly identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

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The Heraeus Cermalloy website does not disclose the identification source or origin of the product but is used solely to identify a particular material. Furthermore, art unit policy is irrelevant as it is not binding and superceded by the MPEP and case law.

In summary, the lone issue is the use of trademarks in claims. The appellant's arguments do not make certain the claim scope as the instant claims only identify a particular material and not an identification source of the product.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Bret Chen  
March 10, 2005

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